REMARKS

A. Amendments

Claims 1–12, 16–17, 27–30, 33, 36, 42, 44, and 46–50 are herein amended. Claims 1–12, 16–24, 27–36, 42, 44, and 46–55 are to remain pending following entry of this amendment.

B. Claim Rejections—35 U.S.C. § 102(e)

In the final Office Action of February 7, 2007 (the "Final Office Action"), the Examiner rejected claims 1–12, 16–24, 27–36, 42, 44, 46–55 under 35 U.S.C. § 102(e) as anticipated by U.S. patent no. 6,839,707 to Lee *et al.* The rejections are traversed, and reconsideration is respectfully requested in view of the following.

Lee Fails to Disclose or Suggest Tabulating Information by Type

Claim 1 claims a system comprising programming that causes at least one computer to cause the display of information, the information tabulated by type. For example, and without intending to limit the claims, Fig. 4 of the application depicts a screen 400 that comprises a plurality of windows 401–405, each dedicated to the display of a separate type of information available for the topic "securities." (Application at ¶ 74.) In the depicted example, the displayed information is tabulated by type within the respective windows 401–405. (*See* Application at ¶ 89.)

In connection with this part of claim 1, the Examiner cites Lee at Figs. 6–17. (*See* Final Office Action at 2.) The applicant respectfully notes that the Examiner does not discuss the relevance of these figures to the limitations of claim 1 and submits that this omission obscures the Examiner's interpretations of "tabulate" and "type" as used in claim 1. The applicant further submits that, however the Examiner interprets the term "type," the wording of claim 1 requires that it be distinct from the "plurality of legal topics," in relation to which the information is stored.

Although the words of the claim are given their "broadest reasonable interpretation," this interpretation must also be consistent with the specification. *See* MPEP § 2111 (8th ed. [R-5] 2006) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 U.S.P.Q.2d 1321 (Fed. Cir. 2005). Moreover, this "broadest reasonable interpretation" is not one that involves stretching the words to give them the maximum possible breadth; the words must be given their plain meaning, except when that plain meaning is inconsistent with the specification. *See* MPEP § 2111.01(I) (8th ed. [R-5] 2006) (citing *In re Amer. Acad. of Science Tech Center*, 367 F.3d 1359, 1369, 70 U.S.P.Q.2d 1827, 1834 (Fed. Cir. 2004). And the "plain meaning" of a claim term "'is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application.'" MPEP § 2111.01(III) (8th ed. [R-5] 2006) (quoting *Phillips*, 415 F.3d at 1313, 75 U.S.P.Q.2d at 1326).

The cited figures in Lee appear to depict various windows that a computer might present on a display when a Web browser is used to access a corporate intranet. (*See* Lee at Figs. 6–17.) The windows comprise various items, controls, or both, some of which are arranged under headings. It is respectfully submitted that, given any reasonable interpretation of the claim terms, the depicted windows fail to disclose or suggest tabulating information according to the type of information, within the meaning of claim 1.

Lee Fails to Disclose or Suggest Accessing Information That Has Been Stored in Relation to at Least One Legal Topic

Lee discusses a legal management system (LMS), describing it as "a fully integrated on-line web-based company-wide communication tool." (Col. 2, lines 31–32.) The LMS, according to Lee, is a centralized and integrated legal department management tool. (*See id.* at col. 2, lines 32–35.) The LMS indexes documents internal to an organization, including model and sample agreements, research memos, and guidelines. (*See id.* at col. 7, lines 5–9.)

The present application discloses, *e.g.*, methods and systems for computerized researching in and monitoring of legal and other professional subjects. (*See* Application at 1, lines 18–20.) Information is provided that relates to legal topics selected from a list of available legal topics. (*See, e.g., id.* at 2, lines 7–10.) The application discloses that, in some cases, it is

advantageous to break down information within a given field into a number of analytical topics. The application also discloses automatic updating of information in the selected topic or topics without further action by the requester. (*See id.* at 2, lines 16–17.)

Thus, claim 1 includes a system comprising at least one database. The database includes information related to a plurality of legal topics, which is stored, in the database, in relation to that plurality of legal topics. The system of claim 1 also includes programming that causes the at least one computer to access information that has been stored in relation to the at least one legal topic.

In connection with this element, the Examiner cites Lee at column 2, lines 14–22. (*See, e.g.*, Final Office Action at 2.) But the cited portion discusses only certain actions involving a database and "legal/business information." It discloses neither the existence of even a single legal topic nor storage of information in relation to such a topic or topics. In fact, Lee nowhere discloses either element.

Lee instead discusses organizing information to reflect the structure of the business or businesses that generate and use it. Thus, according to Lee, information may be displayed in association with a practice group, a regional component of the business, or the role of the information in the business (*e.g.*, "Technology," "Quality," etc.). (*See id.* at col. 8, lines 12–21.) But none of these headings is equivalent to an association between information and one or more legal topics. To the contrary, information relevant to any particular legal topic may be used within multiple practice groups simultaneously, and, conversely, any particular practice group may generate and use information relevant to numerous legal topics.

For example, Lee mentions the subdivision of the "Practice Groups" area into different groups such as Antitrust, Intellectual Property, Intellectual Property, International Law and Policy, and Mergers and Acquisitions. (*Id.* at col. 8, lines 29–32.) The groups are *business units*, not *legal topics,* and specifying one is hardly equivalent to specifying the other. The legal topic of "conflict of laws," for example, is relevant to each mentioned practice group. Even a legal topic such as "antitrust," which shares the name of a practice group, is not necessarily limited to that practice group: it is well known in the relevant arts that the law of antitrust is

relevant to the practices of, among others, intellectual property law, international law, and mergers and acquisitions. It is submitted that this disjunction means that the term "legal topic" cannot reasonably be interpreted to subsume the practice groups of Lee. *See also* MPEP § 2111.01(III) (8th ed. [R-5] 2006) (The plain meaning of a claim term "is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application.").

In further contrast, the LMS in Lee:

> enhances the lines of communication across all attorneys within a legal counsel department and across the globe by enabling the sharing of pertinent legal information and knowledge across teams and by facilitating approval and reviews by decision-makers through the use of on-line comment and feedback capabilities.

(Col. 1, lines 36–42.) It is well known that the "decision-makers" who conduct the discussed "approval and review[]" tend to have responsibilities assigned by business unit, and organization of information by legal topics fails to help them to carry out such responsibilities.

Lee is therefore simply irrelevant to the present application, not least because a practice group is not the at least one legal topic in the at least one database that claim 1 refers to. Indeed, the foregoing distinctions reflect essential disparity: the applicant's disclosures include a system for legal research, but Lee discusses managing workflow and communication within legal practices.

For the foregoing reasons, the applicant respectfully submits that Lee fails to disclose or suggest accessing information that has been related to at least one legal topic, as set forth in claim 1, and therefore fails to anticipate that claim. Pending independent claims 16, 27, 30, 36, 42, 44, 46–47, and 49–50 include limitations corresponding to those already discussed in connection with claim 1, and it is submitted that claims 16, 27, 30, 36, 42, 44, 46–47, and 49–50 are therefore allowable for the same reasons.

Additionally, pending claims 2–12, 17–24, 28–29, 31–35, 48, and 51–55 each depend, directly or indirectly, upon one of claims 1, 16, 27, 30, 36, 42, 44, 46–47, and 49–50. Therefore, these claims should be allowed based at least on their inclusion of subject matter deemed to be allowable for the reasons discussed above. While specific arguments for the patentability of the inventions defined by the dependent claims are not presented herein, the applicant reserves the right to present these arguments in this or a subsequent proceeding.

C. Conclusion

For these reasons, the applicant respectfully requests that the Examiner withdraw the rejections, allow the claims, and pass the application to issue. To expedite prosecution of this application to allowance, the Examiner is invited to call the applicant's undersigned representative to discuss any issues relating to this application.

Respectfully submitted,

Date: June 11, 2007

/Jon E. Gordon/

Jon E. Gordon
Reg. No. 55,217
THELEN REID BROWN RAYSMAN & STEINER LLP
900 Third Avenue
New York, New York 10022
Tel : (212) 895-2000
Fax: (212) 895-2900